

Serial No.: 10/768,225  
Filed: Jan. 30, 2004

Remarks

Examiner has rejected the present application on the following grounds: non-statutory double patenting based on U.S. Patent No. 6,715,427; 35 U.S.C. § 102(e) based on U.S. Patent No. 6,409,031 to Wynne (“the Wynne reference”); and 35 U.S.C. § 103(a) based on the Wynne reference alone or in combination with U.S. Patent No. 6,145,678 to Morrison (“the Morrison reference”).

A. Non-Statutory Double Patenting

As Examiner is aware, a timely filed terminal disclaimer is sufficient to overcome non-statutory double patenting rejection. Applicants have filed herewith a terminal disclaimer under 37 C.F.R. § 1.321(c). Applicants respectfully submit that the non-statutory double patenting objection has been overcome.

B. 35 U.S.C. 102(e)

As Examiner is aware, “[a] rejection based on 35 U.S.C. 102(e) can be overcome by ... [f]iling an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by ‘another’ ... [or] ... [f]iling an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a U.S. patent or a U.S. patent application publication claiming the same patentable invention as defined in 37 CFR 1.601(n).” M.P.E.P. section 706.02(b). Applicants have submitted herewith declarations under 37 §§ 1.131 and 1.132 for all inventors attesting that the present invention was invented prior to the filing date of the Wynne reference and that the Wynne reference describes Applicants’ work, i.e. that the Wynne reference is not the work of “another.”

1. Prior Invention

Applicants submit that the declarations of Michael J. Mikich, Mark C. Torosian, Timothy M. Matthias, and Dwayne Dunseath under 37 C.F.R. § 1.131 are sufficient to establish the prior invention of the claimed subject matter. As attested in the declarations, the suspended shelving claimed was conceived of, and reduced to practice, in or before July 2000. Applicants have submitted with the declarations product drawings and product specifications that were produced in July 2000 (as indicated by the date "7/00" appearing on the drawings). This exhibit clearly establishes that the claimed invention was conceived of, and reduced to practice, over one month before the filing date of the Wynne reference of August 31, 2000. Since the invention was reduced to practice prior to the filing of the Wynne reference, Applicant need not show diligence under 37 C.F.R. § 1.131(b). Applicant submits that all the requirements of 37 C.F.R. § 1.131 have been met to overcome the Wynne reference and, therefore, respectfully submits that the objections based on Wynne be withdrawn.

2. Applicant's Own Work

Applicants also submit that the declarations of Michael J. Mikich, Mark C. Torosian, Timothy M. Matthias, and Dwayne Dunseath under 37 C.F.R. § 1.132 are sufficient to establish that the invention in the Wynne reference describe Applicants' own work. As attested in the declarations, Applicants invented the present invention in or before July 2000 and disclosed their suspended shelf to Folding Guard Company and its president, Dean Wynne, on or about July 21, 2000. Prior to this date, Folding Guard Company was a fencing supplier that did not manufacture shelving. Folding Guard Company, through Dean Wynne, agreed to manufacture the suspended shelf for Applicants' company, HyLoft USA, on July 25, 2000.

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Comparing the Wynne reference to the drawings disclosed to Folding Guard Company in July 2000, it is apparent that the Wynne reference is based on, and derived from, Applicants' work. Under M.P.E.P. § 715.01(c)(II), the Wynne reference may be removed by submission of evidence tending to show that Wynne "derived his ... knowledge of the relevant subject matter from applicant." It is apparent that the owner of a fencing supply company that does not make or supply shelves, but files a patent application for a suspended shelf six weeks after viewing Applicants' drawings and product specifications and agreeing to manufacture Applicants' suspended shelf, almost certainly derived his knowledge of suspended shelving from Applicants. Therefore, Applicants respectfully submit that the Wynne reference is not "by another" as required under 35 U.S.C. § 102(e) and, consequently, the rejection under 35 U.S.C. § 102(e) should be withdrawn.

C. 35 U.S.C. § 103(a)

All the claim rejections in the office action under 35 U.S.C. 103(a) cite Wynne, alone or in combination with Morrison. However, as Applicants have established above, Wynne is not prior art. Therefore, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

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Conclusion

For the reasons advanced above, all pending claims are now believed to be in condition for allowance. Should Examiner believe that a telephone interview would advance the prosecution of this application, the undersigned would invite and request such an interview.

Dated: 7/21/05

Respectfully submitted,  
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